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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,565	01/05/2004	Masaaki Ueda	17339	3667
23389	7590	06/20/2007	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC			JOHNSON III, HENRY M	
400 GARDEN CITY PLAZA				
SUITE 300			ART UNIT	PAPER NUMBER
GARDEN CITY, NY 11530			3739	
			MAIL DATE	DELIVERY MODE
			06/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/751,565

Applicant(s)

UEDA ET AL.

Examiner

Henry M. Johnson, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 April 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 7,9,13,15,20,22 and 26 is/are allowed.
- 6) Claim(s) 1-6,8,10-12,14,16-19,21,23-25 and 27-34 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 January 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

Response to Arguments

Applicant's arguments filed April 18, 2007, with respect to rejections under 35 U.S.C. § 112 have been fully considered and are persuasive and the rejections have been withdrawn.

Applicant's arguments filed with respect to 35 U.S.C. § 102 and 103 have been fully considered but they are not persuasive. Shimmura et al. disclose that the support arm (Fig. 1, # 11a) can pivot or rotate about an axis-of-rotation Oh (paragraph 0057). Such rotation allows the support for the medical device to be positioned above, below or anywhere between these positions as the arm is rotated. The arm with the ball joint (Fig. 7) also disclosed the Oh axis. It is also noted for the record that the position of the ball joint with respect to the instrument is not disclosed as being critical or providing any unexpected benefit.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25, and 27-32 are rejected under 35

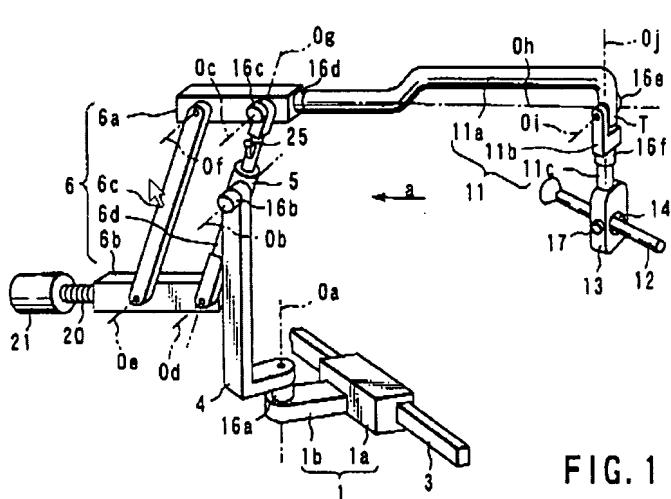


FIG. 1

U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication US 2001/0027313 to Shimmura et al. Shimmura et al. teach a medical instrument holding apparatus with a portion for holding an instrument (Fig.

1, # 14), a support arm (Fig. 1, # 11a), a base support (basal portion, Fig. 1, #s 3 & 4), a shaft coupled to the basal support (Fig. 1, # 4), the shaft forming part of a parallelogram moving (moving mechanism) structure (Fig. 1, # 6) with a counterweight (Fig. 1, # 21) to offset the weight of the support arm (Fig. 1, # 11a) and instrument. Multiple axes of rotation within the supporting mechanism are disclosed (Fig. 1, #s 0a – 0j). Arm 6a is clearly shorter than arm 6c of the parallelogram. A ball joint is disclosed that connects the moving portion to an instrument support portion (Fig. 7, #16h). The support shaft (Fig. 1, # 11a) has an axis-of-rotation (0h), inherently allowing the ball joint to be above, below or on a horizontal plane with the instrument holding means. As the angle of inclination within the ball joint changes, so will the position of the center of gravity, said center of gravity also being dependent on the size and weight distribution of the instrument. Since the center of gravity of the instrument and support depends on the instrument and the orientation, the ball joint is clearly capable of being oriented in any relation to the center of gravity. An operator may grasp any portion of the support and instrument elements. Electromagnetic locks as means for braking their respective movable sections are disclosed (Fig. 1, #s 16a-16f), with an activating switch on the holding portion (paragraph 0059). A braking means is also disclosed for the ball joint (paragraph 0092). The instrument holding portion is interpreted is capable of being held by an operator and is coupled to the support arm by rotatable joints (Fig. 1, #s 16e & 16f). The upper portion of the parallelogram is shorter than the lower portion with the counterweight and either of the side arms. The counterweight is adjustable via screw threads (Fig. 1, # 20).

The apparatus of Shimmura et al. implicitly has centers of gravity, centers of inclination and forces exerted within the device based on the weights of the instrument and counterweights. Relative positions of apparatus components will vary as the instrument is

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positioned and can assume limitless configurations. The apparatus is therefore interpreted as capable of the position(s) cited.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication US 2001/0027313 to Shimmura et al. Shimmura et al. are discussed above and disclose an endoscope as the medical instrument, but do not specifically teach an optical or imaging system. A skilled artisan knows that endoscopes typically include multiple lumens for instruments and observation during an endoscopic procedure. It would have been obvious to one skilled in the art to include optics and imaging in the instrument as it is common and well known to do so.

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Allowable Subject Matter

Claims 7, 9, 13, 15, 20, 22 and 26 are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Henry M. Johnson, III
Primary Examiner
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